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PATENT

Attorney Docket No. 401401

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Sang-cheol LEE

Art Unit: 3753

Application No. 09/982,229

Examiner: A. Flanigan

Filed: October 19, 2001

For: HEATSINK FOR ELECTRONIC
COMPONENT

PETITION FOR RELIEF FROM IMPROPER ELECTION REQUIREMENT

Mail Stop
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant petitions, pursuant to 37 CFR 1.181 for relief from the Examiner's *ex parte* species election requirement mailed July 21, 2003 and particularly from the demand mailed October 7, 2003, in response to the election made August 5, 2003. The Examiner has, for the third time, demanded that the Applicant elect more than one species. This demand is improper and contrary to statute, regulation, and the instructions of the MPEP. Applicant requests that the Examiner be directed to honor the most recent election made, to retract the demand that applicants elect more than one species, to withdraw paper number 11, to examine at least claims 1, 2, 15, and 21, and to rejoin claims upon allowance of a generic claim.

Facts

The referenced patent application was filed as a continuation-in-part patent application on October 19, 2001. A first restriction requirement was mailed on February 26, 2003. In the species election requirement the Examiner identified the patent application as disclosing multiple species of heatsinks, "two species of fan mounting arrangements", "two species of attaching chip arrangements", and "three species of assembly means". The impropriety occurred when, the Examiner required the Applicant elect one species from *each* of the four alleged groups of species that the Examiner defined.

“Applicant is required... to elect a single disclosed species of heatsink, a single species of mounting arrangements, a single species of attachment clip arrangement, and a single disclosed species of assembly means...” Official Action of February 26, 2003, at page 2.

A proper response to this requirement was filed on March 24, 2003. The response traversed the species election requirement because it was not consistent with 37 CFR 1.142(a) and Chapter 800 of the MPEP. Reconsideration was requested. In addition to the traverse, an election of one species, the species of Figure 5 of the patent application, was made. The claims pertaining to that figure were identified.

In reply to the election, a paper was mailed on May 5, 2003, stating that the election was not responsive because one species from each group was not elected. The Examiner demanded the Applicant file a further response and pay an extension of time fee in order to avoid abandonment of the application.

As documented in the response filed May 21, 2003, a response in which a second request for reconsideration of the species election requirement was made, the undersigned and the Examiner discussed by telephone the unorthodox species election requirement; no progress was made. In the response filed May 21, 2003, Applicant explained the impossibility of electing more than one species and simultaneously identifying a coherent group of claims for examination. Applicant requested examination of the claims pertaining to the single elected species, claims 1, 5, and 23.

After the filing of the second election on May 21, 2003, the Examiner withdrew the initial species election requirement and imposed a new species election requirement on July 21, 2003. This species election requirement was again improper, and not in keeping with the Regulations and the instructions of the MPEP.

In the second species election requirement, mailed July 21, 2003, the Examiner identified as distinct species Figure 2, Figures 17A-17C, Figure 17D, and Figure 5. The Examiner listed various “unillustrated species” and the claims that pertained to the unillustrated species. The Examiner also identified the claims that pertained to the species identified by figure.

The Official Action continued that the “application further contains claims directed to the following patentably distinct species of fan/heatsink combination: The species of Figs. 2, 4 (direct attachment of fan, claims 9-11), and the species of Fig. 7 (claims 12-14).”

The Examiner then imposed another improper election demand.

“Applicant is required under 35 U.S.C. 121 to elect a single disclosed species of heatsink configuration, *and* a single disclosed species of fan/heatsink combination for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claim 1 is generic.” The Official Action of July 21, 2003 at page 3, emphasis in the original.

In an election filed August 5, 2003, Applicant elected a single alleged species, Figures 17A-17C, identified the claims pertaining to that species (2, 15, and 21), traversed, again, the species election requirement imposed by the Examiner, and requested reconsideration for the third time.

In the paper mailed October 7, 2003, the Examiner stated that the election filed August 25, 2003, was non-responsive because the “response failed to elect a fan/heatsink combination as required on pps. 2-3 of the election requirement of 7/212/03 [sic] (either the species shown in Figs. 2, 4 with the fan directly attached, or the species of Fig. 7 with the fan attached via a clip)”. In other words, Applicant was cited again for failing to elect more than one species. This Petition responds to the paper mailed October 7, 2003.

Request for Reconsideration

Applicant has requested reconsideration three times of the improper species election requirements that have been made in this patent application. A further request for reconsideration would be pointless. Therefore, Applicant requests supervisory review and instructions so that this patent application, now pending for more than two-years, with domestic priority date of November 4, 1999, can have some claims examined on the merits.

Rules for Species Election Requirements and Elections

The statute, the regulations, and the instructions of the MPEP concerning species election requirements and species elections are unambiguous. The statutory basis for restriction, cited by the Examiner, is 35 U.S.C. 121.

“If two or more independent and distinct inventions are claimed in one application, the Director may require the application be restricted to *one* of the inventions.” (Emphasis supplied.)

The controlling rule, also cited by the Examiner, is 37 CFR 1.142(a), “the examiner in an Office action will require the applicant... to elect *an* invention to which the claims will be restricted” (Emphasis supplied.) This regulation, implementing the statute, is the sole rule from which authorization is drawn for imposing species election requirements. The rule requires, when a species election requirement is imposed, that Applicant be required to elect one invention, not *at least* one invention.

The MPEP, in its instructions to Examiners, is more detailed. At section 818, an election is defined. “Election is a designation of the particular *one* of two or more disclosed inventions that will be prosecuted in the application.” (Emphasis supplied.) The process defined is not the designation of at least two inventions disclosed in the patent application but, consistent with the Rule, defines election as the designation of *one* disclosed invention.

In a species election requirement what is to be elected is a species. MPEP section 806.04(d) defines what is meant by a species. “*Species are always the specifically different embodiments.*” MPEP section 809.02(a) directs Examiners to identify figures of a patent application, when figures are present, to designate species. Only in the absence of figures are Examiners to identify species by their characteristics. Subsection (c) of that section further informs Examiners that an Applicant “should be required to elect a *single* disclosed species.” (Emphasis supplied.) Once an Examiner has imposed a species election requirement, MPEP section 818.03(e) directs that the Applicant “must make his or her own election. The Examiner will not make the election for the Applicant.”

The foregoing requirements have not been followed in the course of the three species election requirements imposed in this patent application. Each of the three species election requirements expressly required the Applicant to elect at least two of the species identified by the Examiner. This demand violates 37 CFR 1.142(a) as well as each of sections 808.01(a), 809.02(a), and 818.03(e) of the MPEP.

Many of the species designated by the Examiner, particularly in the third species election requirement, are not embodiments described in the patent application. Rather, many of the so-called species are mix-and-match combinations of the embodiments illustrated in the patent application that have been assembled by the Examiner. The Examiner expressly acknowledged in the third species election requirement that some so-called species are not illustrated. Since the patent application includes nineteen figures, the designation of “unillustrated species” violates the instruction of MPEP 809.02(a) and is contrary to MPEP 806.04(e).

Finally, by designating species, as exemplified in the third species election requirement, and requiring the Applicant to elect two specific alleged species, the Examiner

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is in direct violation of MPEP 818.03(e). It is not the Examiner's role to direct the Applicant to elect particular species, only to designate the species.

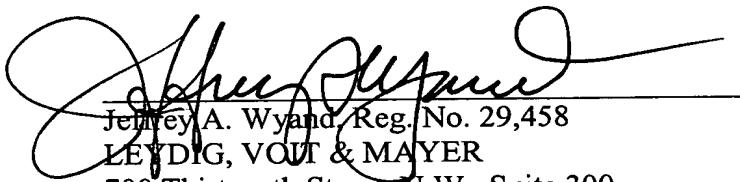
Relief Requested

The entire procedure that has so far been followed in the prosecution of this patent application is improper and contrary to the instructions of the USPTO to Examiners. The expensive, time-consuming and wasteful delay suffered by the Applicant in the attempted prosecution this patent application must be stopped. The examination process must be redirected to the procedures established by the USPTO. Otherwise, Applicant may be denied the opportunity to participate in a rational and defined examination process.

In summary, Applicant requests that the Examiner be directed to examine on the merits the claims that the Examiner acknowledges pertain to the elected species, claims 1, 2, 15, and 21, that the Examiner be instructed that he cannot require any applicant to elect more than one alleged species, that the Examiner be directed to withdraw the requirement of the paper mailed October 7, 2003, and that the Examiner be required to, upon the allowance of any examined generic claim, permit the rejoinder to the prosecution of claims pertaining to allowed generic claims.

No fee is required with this Petition.

Respectfully submitted,


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Date: November 6, 2003
JAW/tps

Amendment or ROA - Regular (Revised 9/03/03)